

RECEIVED
CENTRAL FAX CENTER

AUG 24 2007

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for maintaining the indication that claims 9, 11, 14 and 16 are allowable.

As a further initial matter, the undersigned would like to thank the Examiner for the courtesy and assistance extended on behalf of the Applicants during the telephonic interviews conducted on August 21 and 22, 2007, with the undersigned.

In the Final Official Action, the Examiner rejects claims 1-8, 10, 12, 13, 15, 19-25 and 28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2003/0117491 to Avni et al., (hereinafter "Avni"). Furthermore, the Examiner maintains the rejection of claims 17, 18, 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Avni in view of European Patent No. 0912047 to Matsumoto et al., (hereinafter "Matsumoto").

In response, Applicants again respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(e) and 103(a) for at least the reasons set forth below.

Claims 1, 7, 12 and 17-19 recite that the switching device switches illuminating conditions of the illuminating light irradiated by the illuminating device, presets at least two different illuminating conditions and a switching order thereof, and automatically switches the illuminating conditions from a first illuminating condition corresponding to a first image acquisition cycle to a second illuminating condition corresponding to a subsequent image acquisition cycle.

Applicants previously argued that Anvi only discloses that the maximum illumination time (ΔT_4) is preset. The maximum illumination time is the maximum time the light sources (63A, 63B, 63C and 63D) remain on for any illumination cycle (see paragraph

[[0074]]. Anvi does not disclose any other preset illumination times or conditions. Although the illumination time ($\Delta T6$) in the first illumination cycle ($\Delta T1$) is different from the illumination time ($\Delta T7$) in the second illumination cycle ($\Delta T2$), such illumination times ($\Delta T6$, $\Delta T7$) are not preset. The illumination times ($\Delta T6$, $\Delta T7$) are generated based on a detection of the light sensing unit (67). When the light detected by the light sensing unit (67) reaches a threshold value, the light sources (63A, 63B, 63C and 63D) are turned off (thus defining the illumination time) (see paragraphs [0078 and 0079] and [0083-0086]). Therefore, the illumination times for each illumination cycle are not preset but vary as a function of light detected by the light sensing unit (up to a maximum of $\Delta T4$).

In the "Response to Arguments" section of the Final Official Action, the Examiner argues that "as broadly as claimed" Anvi discloses a capsule apparatus having a switching device that presets at least two different illuminating conditions and meets the limitations of the recited claims.

From the Examiner's comments, it appears that he considers one of the preset illuminating conditions to be the maximum illumination time ($\Delta T4$) and the other preset illuminating condition to be the preset threshold value. The Examiner confirmed as such during the interviews with the undersigned.

Thus, according to the Examiner's broad interpretation, the threshold value may be considered an illuminating condition. However, claim 1 requires that the illuminating conditions be switched from one illuminating condition to the other. Thus, the threshold value cannot be considered an "illuminating condition" within the context of the claim because the illuminating condition is not "switched" to the threshold value, the threshold value is merely used to perform a comparison.

Furthermore, in each illumination cycle ($\Delta T1$) disclosed in Avni, the illumination time is EITHER $\Delta T4$ OR $\Delta T6$ or $\Delta T7$. Therefore, the illumination time is not switched between such values, it is one or the other.

Still further, even if Applicants were to agree to such an interpretation (which they do not for at least the reasons set forth above), the claims recite switching from a first illumination condition corresponding to a first illumination cycle to a second illumination condition corresponding to a subsequent illumination cycle. That is, the switching between preset illumination conditions takes place in different illumination cycles. At best (if you agree with the Examiner's arguments), Avni discloses switching between preset illumination conditions ($\Delta T4$ and the "threshold value") in the same illumination cycle ($\Delta T1$).

For at least such reasons, Applicants respectfully submit that Avni does not disclose the features recited in independent claims 1, 7, 12 and 17-19.

With regard to the rejection of claims 1-8, 10, 12, 13, 15, 19-25 and 28 under 35 U.S.C. § 102(e), a capsule endoscope apparatus having the features discussed above and as recited in independent claims 1, 7, 12 and 19, is nowhere disclosed in Avni. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 1, 7, 12 and 19 are not anticipated by Avni. Accordingly, independent claims 1, 7, 12, and 19 patentably distinguishable over Avni and are allowable. Claims 2-8, 10, 13, 15, 20-25 and 28 being dependent upon claims 1, 7, 12, and 19, are thus at least allowable therewith.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-8, 10, 12, 13, 15, 19-25 and 28 under 35 U.S.C. § 102(e).


With regard to the rejection of claims 17, 18, 25 and 26 under 35 U.S.C. § 103(a), Independent claims 17 and 18 are not rendered obvious by the cited references because neither the Avni patent nor the Matsumoto patent, whether taken alone or in combination, teach or suggest a capsule endoscope apparatus having the features described above. Claims 26 and 27 being dependent upon claims 17 and 18 are thus at least allowable therewith. Accordingly, claims 17 and 18 patentably distinguish over the prior art and are allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 17, 18, 25 and 26 under 35 U.S.C. § 103(a).

Lastly, new claims 23-28 have been amended to simplify the same. The amendment to claims 23-28 is fully supported in the original disclosure, such as from page 22, line 10 to page 23, line 5 of the specification. Thus, no new matter has been entered into the disclosure by way of the amendment to claims 23-28. During the interview, the Examiner indicated a willingness to enter and consider the amendment to claims 23-28.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

TS:ae